

error in the prosecution of the patent. The Applicants submit that commercial development after the issuance of a patent is often the reason an error is discovered.

A good example of this type of situation is In re Wilder, 736 F. 2d 1516 (Fed. Cir. 1984), which concerned a patent on a dictating machine. Shortly after the patent issued, the assignee of the patent began selling a new dictating machine known as the "Thought Master II" machine. After several months had passed, one of the inventors met with the assignee's patent attorney and asked him to investigate whether the claims of the patent read upon the new machine. The attorney discovered that the claims did not read upon the machine. Upon further study, the attorney concluded that the claims were narrower than the prior art required. A broadened reissue application was filed with new claims reading upon the new machine. The Court of Appeals for the Federal Circuit noted that the attorney had failed to appreciate the full scope of the invention and this error was discovered "after commercialization of the invention and issuance of the patent" and held that these facts satisfied the requirements of 35 U.S.C. §251.

A similar situation occurred in Application of Wadlinger, 496 F. 2d 1200 (CCPA 1974), where a patent issued with claims directed to a crystalline zeolite catalyst composition. After the patent issued, it was discovered that the catalyst performed surprisingly well in certain hydrocarbon reactions. See note 2. A reissue application was then filed to add process claims. The Court held that these facts satisfied the requirements of 35 U.S.C. §251.

In summary, the critical consideration in reissue is whether an error occurred without deceptive intent. How that error is finally discovered is of little or no importance. In any event, it is well established that discover-

ing the error after the issuance of the patent and as a result of commercial development does not bar reissue. Accordingly, the Applicants request that the rejection based on a defective reissue declaration be withdrawn.

REMARKS REGARDING THE SECTION 103 REJECTION

In the Office Action dated January 31, 1990, the Examiner also rejected Claims 12 and 13 under 35 U.S.C. §103 as being unpatentable over Paschal, U.S. Patent 2,694,396, issued Nov. 16, 1954, in view of Beck, German Patent 645,391, effective Mar. 30, 1932. Claim 12 has been amended and Claim 13 has been cancelled. The Applicants traverse the rejection as to amended Claim 12.

Before considering the art rejection, a brief review of the Applicants' invention may be helpful. The Applicants' touch enhancing pad is apparently the first device to actually enhance the sense of touch. The pad comprises an enclosure of a relatively thin, strong, elastic, and pliable material with a liquid lubricant sealed within. The touch enhancing pad of this invention is manufactured and sold by Inventive Products, Inc., the assignee of the invention and of this application, under the trademark SENSOR PAD®. An affidavit of Grant A. Wright, president of Inventive Products, Inc., is attached. This affidavit details some of the secondary considerations as they relate to the SENSOR PAD®, including its commercial success, professional recognition, and competitive recognition.

Turning now to references relied upon by the Examiner, Paschal, the primary reference, discloses and claims a massaging device consisting of two pieces of satin fabric. In column 2, Paschal mentions a second embodiment of the massaging device consisting of "a sheet formed of flexible

plastic material or any other suitable flexible material which is impervious to liquid and a second sheet of the same or like material fused or seamed together. . .near the edges thereof and having sealed in the interior thereof a lubricant."

There are several reasons why Paschal cannot possibly have contemplated the materials disclosed and claimed for use in the Applicants' touch enhancing pad. First of all, there is no indication that Paschal ever made this second embodiment of his massaging device. Secondly, he does not identify a single specific "flexible plastic" composition and it is likely that this embodiment was merely a creation of the imagination of Paschal's patent attorney. Thirdly, and most importantly, in 1951 when Paschal's application was filed, a "flexible plastic" material having the properties necessary for touch enhancement was not only unavailable, but unknown. This fact is dramatically illustrated in an affidavit by Professor Thaddeus C. Ichniowski attached hereto.

Professor Ichniowski, a professor of polymer chemistry at Illinois State University with extensive education and experience in the field of polymeric (plastic) products and also with considerable experience in working with and analyzing patents, is exceptionally qualified to analyze and comment on the disclosure in Paschal. It is the opinion of Professor Ichniowski that the quoted language from Paschal does not teach and cannot suggest the materials specified by the Applicants for use in the touch enhancing pad. By way of example, "sheets" in Paschal could not possibly define materials suitable for the Applicants' invention because the materials to make such "sheets" were clearly not available at the time Paschal made his invention. This fact was

further confirmed by a search of Chemical Abstracts, one of the most respected and complete depositories of chemical information in the world.

The secondary reference, Beck, discloses a massage safety cushion consisting of rubber filled with a lubricant. The cushion is intended for use with a separate "massaging element." Suitable "massaging elements" are rubber pads provided with ribs or projecting pins, bags filled with balls, hollow-walled air-filled bags having ribs on the exterior walls, and also the hands themselves. A second affidavit by Professor Thaddeus C. Ichniowski shows that Beck could not possibly have contemplated a product similar to the Applicants' touch enhancing pad back in the early 1930's when he made his invention - a time when we were still tapping rubber trees and making molded products only from natural rubber. None of the synthetic rubbers had been invented at that time in history and certainly plastic products capable of being made into thin, pliable sheets were not only unknown but probably not even dreamed about. The "rubber" available on March 30, 1932, the filing date of Beck, could not possibly have provided or even suggested the materials of construction of the Applicants' touch enhancing pad because neither synthetic rubbers nor plastics were known and the uses of compounded natural rubber were very limited.

Thus, the "flexible plastic" materials mentioned by Paschal which were available in 1951 did not possess the properties required for touch enhancement. Similarly, the rubber safety cushion mentioned by Beck available in 1932 did not possess the required properties. Accordingly, even if either of these embodiments were actually built and used for massaging, the sense of touch of the massager would not be enhanced.

Turning now to the Section 103 combination rejection, the Examiner states that the device recited in original Claim 12 would have been obvious to one of ordinary skill in the art in view of the teachings of Paschal and Beck. The Examiner's rationale for the rejection is that Paschal teaches that the enclosure can be made from "flexible plastic material which is impervious to liquid" and that Beck teaches that natural rubber is suitable for massaging devices. There are a number of reasons the Applicants' invention as now claimed is not rendered obvious by these teachings.

First of all, it is well to review the law relating to obviousness by a combination of references. The Court of Appeals for the Federal Circuit, in In Re Wright, 848 F. 2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988), held that "the question [of obviousness] is whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working." The Court went on to state that "Factors including unexpected results, solution of a different problem, novel properties, are all considerations in the determination of obviousness." Commentators have suggested that, for a determination of obviousness, there is a threshold requirement that the prior art contain a suggestion or teaching of a solution to the problem that the applicant faced.

The "problem" faced by the Applicants was the enhancement of the sense of touch. Paschal and Beck, as previously discussed, never mention touch enhancement. The prior art that does address the sense of touch teaches away from the Applicants' invention by stating that the sense will be diminished if a thin layer of material is placed between the

skin and the object to be touched, and that the sense will be further diminished if the thickness of the layer increases or if the number of layers increases. Nothing in the prior art suggests any method of touch enhancement and certainly does not suggest that the use of two layers of material could possibly enhance the sense of touch. Accordingly, because the prior art does not even address the problem of touch enhancement, the threshold requirement for a determination of obviousness is not met.

Furthermore, unexpected results are strong evidence of unobviousness. The Applicants discovered these touch-enhancing properties by accident and one literally has to handle the touch enhancing pad to fully comprehend its properties. Nothing in Paschal or Beck suggests that an enclosure of a thin, pliable material with a liquid lubricant sealed within would have such properties.

It is submitted that the combination of Paschal as a primary reference and Beck as a secondary reference is improper because neither reference suggests such a combination. Combination rejections are permitted only when the references suggest expressly or by implication the possibility of achieving improvements by the combination. See, e.g., In re Sernaker, 702 F. 2d 989 (Fed. Cir. 1983).

It is also submitted that the combination is improper because the combination produces an inoperative result. As discussed during the prosecution of the parent case, natural rubber cannot be effectively sealed to provide the Applicants' invention. Paschal states that the enclosure is formed of two sheets of material "fused or seamed together." Accordingly, the Paschal device could not be made of natural rubber without a bulky, physical seam holding the two pieces together.

In view of the amendments to Claim 12, the enclosed affidavits, and the above remarks, allowance of Claims 1 to 12 is requested.

Respectfully submitted,

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CERTIFICATE OF MAILING

PHILIP L. BATEMAN certifies that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C., 20231, on April 23, 1990.

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